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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,038	01/15/2002	Junji Tanaka	8014-1002	2907

466 7590 08/26/2004
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EXAMINER

PATEL, GAUTAM

ART UNIT	PAPER NUMBER
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2655

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DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,038

Applicant(s)

TANAKA, JUNJI

Examiner

Gautam R. Patel

Art Unit

2655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-4 are pending for the examination.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119(a)-(d), which papers have been placed of record in the file.

NOTES & REMARKS

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which Applicant may become aware in the specification.

Specification

4. The disclosure is objected for following reasons.
The title of the invention is neither precise nor descriptive. A new title is required which should include, using twenty words or fewer, claimed features that differentiate the invention from the Prior Art. It is recommended that the title should reflect the gist of or the improvement of the present invention.

Correction is required.

Claim Rejections - 35 U.S.C. § 112

5. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3-4 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Art Unit: 2655

Output of the sample and hold circuit is not described in way that makes o=it clear what the circuit is doing. On page 11, fig. 4 describes the sample and hold circuit and associated details. But it does not correlate with what is being claimed. Accordingly, the specification does not explain to one of ordinary skill in the art at the time of the invention, how to make and or use the invention comprising the claimed "said sample hold circuit outputs, during the period of applying of the second light beam, the read signals input during the period while holding the same, and outputs, during the period of applying of the first light beam, the read signals held during the applying of the second light beam".

6. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-5 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4, lines 13-17 "said sample hold circuit outputs, during the period of applying of the second light beam, the read signals input during the period while holding the same, and outputs, during the period of applying of the first light beam, the read signals held during the applying of the second light beam" is confusing and unclear. It is not clear what is meant by "the same", what this "same" pointes to and how it is related to hold period.

Claim Rejections - 35 U.S.C. § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-2 are rejected under 35 U.S.C. § 102(e) as being anticipated by Kuroda et al., US. patent 6,181,657 (hereafter Kuroda).

As to claim 1, Kuroda discloses the invention as claimed [see Figs. 5-12, especially 11-12] including a light beam applying device, a read signal generating device and a pre-pit signal detecting device comprising:

a light beam [fig.11, unit 93] applying device [unit 92] for applying a first light beam having first power [recording power] and a second light beam having second power [reading power] different from the first power to the pre-pits on a time-shared basis according to the record information when recording the recording information on the recording medium [col. 7, lines 35-64];

a read signal generating device [fig. 11, units 93, 94, 95, 90, 91 and 96] for generating read signals from electrical signals according to the amounts of reflected light of the respective beams; and

a pre-pit signal detecting device [fig. 11, units 90, 96 and 91] for inputting the generated read signal and detecting a pre-pit signal from the input read signal, wherein said pre-pit signal detecting device detects a pre-pit signal from only the read signals input during the period of applying of the second light beam [col. 7, line 35 to col. 12, line 35].

8. The aforementioned claim 2, recites the following elements, inter alia, disclosed in Kuroda:

the first power is higher than the second power [col. 7, lines 49-53 and fig. 12].

9. A search based on the best understanding of the claims has been made to find the most pertinent art, but no statement about invention will be appropriate at this time regarding the allowableness of claims 3-4 and no art rejection will be made in this office action regarding the claims 3-4, due to the speculation required to interpret the claims because of their indefiniteness under 35 U.S.C. 112, 1st and 2nd paragraphs as noted above (see *In re Steele*, 134 USPQ 292).

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Other prior art cited

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Yoshida et al. (US. Patent 5,930,222) "**Pre-pit detecting device**"
- b. Kuroda (US. patent 6,522,608) "Information recording"
- c. Yanagawa (US. patent 6,246,660) "Device for controlling the power ..."

Contact Information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam R. Patel whose telephone number is (703) 308-7940. The examiner can normally be reached on Monday through Thursday from 7:30 to 6.

The appropriate fax number for the organization (Group 2650) where this application or proceeding is assigned is (703) 872-9314.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Doris To can be reached on (703) 305-4827.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-4700 or the group Customer Service section whose telephone number is (703) 306-0377.



Gautam R. Patel
Primary Examiner
Group Art Unit 2655

GAUTAM R. PATEL
PRIMARY EXAMINER

August, 21, 2004